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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,329	11/02/2005	Tadahiro Ohmi	5016-0101PUS1	5081
2292 7590 02/03/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
DINH, TUAN T				
ART UNIT		PAPER NUMBER		
2841				
NOTIFICATION DATE		DELIVERY MODE		
02/03/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/525,329

Applicant(s)

OHMI ET AL.

Examiner

Tuan T. Dinh

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 2-7, 10, 11 and 13-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8, 9 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date 8/28/08, 02/22/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Specie I (figure 2, claims 1, 8-9, and 12) in the reply filed on 12/03/08 is acknowledged. The traversal is on the ground(s) that ten (10) Species are joined by single general invention concept. This is not found persuasive because there is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 8-9, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanba et al. (U.S. Patent 5,870,065).

As to claim 1, Kanba et al. discloses a circuit board as shown in figures 1-3, and 10 having an insulator layer (11a, 11b) and a conductor (12) buried inside said insulator layer, said circuit board characterized in that said insulator layer (11a, 11b) comprises a first insulator satisfying a relationship of $\mu_r (=20) \geq \epsilon_r (=6)$ given that a relative permittivity is μ_r and a relative permeability is ϵ_r , and said conductor is substantially surrounded by said first insulator.

As to claim 8, Kanba et al. discloses said first insulator contains a synthetic resin (11a contained 13a-13d) and a magnetic substance (11b contained 13e), see column 3.

As to claim 9, Kanba et al. discloses said synthetic resin, which is a silica, see column 3, lines 25-29, is at least one resin selected from the group consisting of an epoxy resin, a phenol resin, a polyimide resin, a polyester resin, a fluorine resin, a denatured polyphenylether resin, a bismaleimide triazine resin, a denatured polyphenylene oxide resin, a silicon resin, a benzocyclobutene resin, a polyethylene naphthalate resin, a polycycloolefin resin, a polyolefin resin, a fluorocarbon polymer, a cyanate ester resin, a melamine resin, and an acrylic resin.

As to claim 12, Kanba et al. discloses a circuit board as shown in figures 1-3, and 10 comprising an insulator layer (11a, 11b) having opposing first and second main surfaces, and first and second wiring layers (terminals 54) formed on said first and second main surfaces of said insulator layer, wherein at least a part of said insulator layer satisfies a relationship of $\mu_r (=20) \geq \epsilon_r (=6)$ given that a relative permittivity is μ_r and a relative permeability is ϵ_r , and said conductor is substantially surrounded by said first insulator.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tanabe et al., Ikezi et al., and Ozeki et al. disclose related art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan T. Dinh whose telephone number is 571-272-1929. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reichard Dean can be reached on 571-272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tuan T Dinh/
Primary Examiner, Art Unit 2841.